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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,584	03/18/1999	EDUARDO BLUMWALD	4001	4345

7590 12/17/2003

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EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/271,584	Applicant(s) BLUMWALD ET AL.	
	Examiner Anne R. Kubelik	Art Unit 1638	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 21 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,5,7,8,10-12,14,18,19,21-32, 53,54,56.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


Continuation of 2. NOTE:

New matter: The amendments to the specification constitute new matter. Applicant urges that the hybridization and wash conditions are brought from the 5,750,848 patent, which was incorporated by reference. This is not found persuasive because the '848' patent was incorporated by reference with respect to modifying DNA and proteins, preparing recombinant nucleic acids and vectors, cell transformation, and expression of proteins (see pg 34, lines 5-14 of the specification), not for hybridization. The recitation of a wash time of 15 minutes in part (c) of claims 1 and 18, and part (a, iii) of claim 53 is thus also new matter. .

Continuation of 3. Applicant's reply WOULD HAVE overcome the following rejection(s):
112, 1st, enablement and written description, 112, 2nd, 102 and 103..

Continuation of 5. does NOT place the application in condition for allowance because: Applicant urges that the claims have been amended to be in condition for allowance. This is not found persuasive for the reasons indicated above.

Continuation of 10. Other: Claims to plants transformed with SEQ ID NO:1, nucleic acids encoding SEQ ID NO:2, or nucleic acids encoding Na⁺/H⁺ transporters with 95% identity to SEQ ID NO:2 would be allowable, as would methods of using those nucleic acids to produce those plants. The amendments to the specification addressing insertion of sequence identifiers would be entered if presented with allowable claims.



ASHWIN D. MEHTA, PH.D
PATENT EXAMINER